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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,628	04/09/2004	Helmut Harrer	12484/3	8931
757	7590	11/23/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			GUADALUPE, YARITZA	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,628	<b>Applicant(s)</b> HARRER, HELMUT	
	<b>Examiner</b> Yaritza Guadalupe McCall	<b>Art Unit</b> 2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

In response to Applicant's remarks filed September 7, 2005

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 9 - 11 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Ernst (US 4,495,700).

With respect to claim 1, Ernst discloses a position measuring system ( See Figure 6 ), comprising a housing ( 64 ) comprising a wall, said wall having an opening ( 67 ) and comprising a deformation ( note how the opening shows an alteration to its form and shape ); a measurement device ( See Column 5, lines 36 – 48 ) accommodated in said housing ( See Figure 6 ), said measurement device detecting and processing measurement values and outputs a position-dependent measurement signal; a cable ( 66 ) comprising what could be considered a shield ( as suggested from Figure 6 where it is shown a shield covering three signal lines that are attached to the measurement device ), wherein said cable is positioned within said opening and is

electrically connected to said measurement device so as to carry said measurement signal; and wherein said deformation of said wall fixes said cable in said opening and for binding said shield to said housing.

Regarding claim 9, Ernst discloses a position measuring system wherein said housing (64) is embodied cylindrically with an end wall and a code disk ( 53 ) that measures angles and contains a detector device ( 54 ) that scans the code disk.

In regards to claim 10, Ernst also discloses a position measuring system wherein said opening ( 67 ) extends transversely to a longitudinal axis of said housing and is disposed on said end wall.

With respect to claim 11, Ernst teaches a position measuring system wherein said end wall, in a region of said opening, has a swelling of material ( See Figure 6 ).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst ( US 4,495,700 ).

Ernst discloses a position measuring system as stated in paragraph 2 above.

Ernst does not disclose the adhesive or ply as stated in claims 6 and 7.

With regards to claims 6 and 7 : Ernst discloses a housing ( 64 ) having an opening ( 67 ) provided with a material ( as suggested from figure 6 ), however, the particular material being used has not being disclosed. The particular type of material used to fixedly attach said cable in said opening, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960 ) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Ernst by using an adhesive or ply on said opening, since these are both well known fasteners that are used alternatively to securely hold a structure to a surface.

5. Claim 2 – 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst (US 4,495,700 ) in view of Schneider et al. ( US 6,531,880 ).

Ernst discloses a position measuring system as stated in paragraph 2 above.

Ernst does not disclose the jacket surrounding the shield as stated in claim 2.

In regards to claim 2 : Ernst discloses a position measuring system comprising a cable (66) and a shield but fails to specify the use of a jacket. Schneider et al. discloses a system comprising a sensor ( 102 ) including a cable ( 140 ) electrically connected to it, said cable including signal lines ( 142 ) and a shield ( 144 ) and further comprising an outer jacket (140, which surrounds the shield and the signal lines 142 as shown in Figure 1 ) that surrounds a shield; said shield surrounds said signal lines, and said shield in said opening is in electrical contact with said housing in order to ensure an optimum and maximum energization of the cable and prevent from physical damage, i.e., overheating, to the sensor or other components of the system. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the cable disclosed by Ernst with a cable having a shield, a jacket and signal lines as taught by Schneider et al. in order to ensure an optimum and maximum energization of the cable and prevent from physical damage, i.e., overheating, to the sensor or other components of the system.

In regards to claim 3, the combination of Ernst and Schneider also discloses said deformation ( 10 ) comprising a first portion in which said wall does not contact said shield and a second portion in which said wall contacts said shield ( See Figure 1 ).

Regarding claim 4, the combination of Ernst and Schneider teaches said first portion wherein said wall directly contacts and surrounds the circumference of said jacket.

In regards to claim 5, the combination of Ernst and Schneider teaches said second portion wherein said shield is turned back onto said jacket.

With regards to claim 8 : Ernst and Schneider disclose a housing ( 8 ) having an opening but does not specifies any material being used to secure said cable in said opening. The particular type of material used to fixedly attach said cable in said opening, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960 ) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Ernst and Schneider by using an elastic ply on

said opening, since this is a well known fastener that is commonly used to securely hold a structure to a surface.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1 – 11 have been considered but are moot in view of the new ground(s) of rejection.

Applicant arguments regarding the Ernst reference not teaching a deformation are not persuasive. Applicant contends that the deformation ( 67 ) shown by Ernst is a separate component from the wall and that it is not a deformation of the very same wall. The Examiner disagrees since the claimed subject matter is silent to indicate whether the “deformation” as claimed is integral or separate from the wall. As best understood by the Examiner, a deformation requires only to be an “alteration to its form and shape”, as defined by Webster’s Collegiate Dictionary 10<sup>th</sup> Edition, and the deformation shown by Ernst clearly meets this criteria. Applicant is reminded, that upon examination of a claim, claims are given their broadest interpretation and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



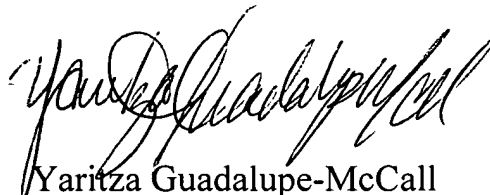
*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe McCall whose telephone number is (571)272-2244. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YGM  
November 18, 2005

  
Yaritza Guadalupe-McCall  
Patent Examiner  
Art Unit 2859